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APPEALS
REFERENCES

**RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3641**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

28

For: METHOD TO CONTROL REACTIONS
INVOLVING ISOTOPIC FUEL
WITHIN A MATERIAL USING
ORTHOGONAL ELECTRIC-FIELDS

Serial no. 09/ 748,691

Filed: 12/26/2000

This is a division of Serial no. 07/ 760,970

Filed: 09/17/1991

Group Art Unit: 3641
Examiner: Palabrica, R.J.

November 23, 2003

DECLARATION OF DR. MITCHELL SWARTZ

I, Mitchell R. Swartz, declare that I am a citizen of the United States of America and the inventor of the invention described in the above-entitled application.

1. I have a background in electrical engineering, material science, electrochemistry, and medicine, and have worked in this field for more than a decade, and have worked on experimental projects at the Massachusetts Institute of Technology, Massachusetts General Hospital and elsewhere.

2. I received the Office's communication dated 11/18/03 (cover as Exhibit "A", attached). Said communication is stamped and signed by Michael Carone.

3. Said office communication purports that there are errors in the Appeal Brief dated Sept. 17, 2003 of the above-entitled action. However, analysis reveals that it is Mr. Carone who has made a series of errors with respect to these matters.

4. In the following, the Communication from the office dated November 18, 2003 (Exhibit "A") will hereinafter, be referred to as the "Communication of 11/18/03" or the "second Office Communication". Also, in the following, the Appellant will refer to his previously submitted "Notice of Compliance by Appellant" which was dated Sept. 17, 2003. Hereinafter, this will be referred to as the "Notice". In addition, in the following, the Appellant will refer to his previously submitted (in triplicate) Appeal Brief dated Sept. 17, 2003. Hereinafter, this will be referred to as the "Appeal Brief". Also, previously, Appellant

received a communication from the office dated 8/28/03 (copy attached as exhibit "B"). Hereinafter, this will be referred to as the "Communication of 8/28/03" or the "first Office Communication".

5. Mr. Carone purports that there is "subject matter not found in the specification". This is not true. I addressed this matter in the "Notice of Compliance by Appellant", dated Sept. 17, 2003 on page 2. I did correct it on pages 4 through 7 in the Appeal Brief, as said Notice stated on page 2.

6. The Office's Communication inaccurately states, "2. The recitation of Issues is still improper (see item c of the previous OA)." The Office is wrong. I properly addressed this matter in my "Notice of Compliance by Appellant", dated Sept. 17, 2003 on pages 3 and 4. I did correct it on pages 8 through 9 in the Appeal Brief, as said Notice stated on pages 3 and 4.

7. The Office's Second Communication invents a new argument and inaccurately states, "The section still contains issue not relevant to the examiner rejections." The Office is wrong, and is nonspecific. The Office has also ignored my "Notice of Compliance by Appellant", dated Sept. 17, 2003, pages 3 and 4.

8. The Office's Communication inaccurately states, "The claimed "operability" of the invention is not a 35 U.S.C. 112, first and second paragraph issues, but a 35 U.S.C. 101 issue." The Office is wrong. In fact, the Office has cited "operability" pursuant to 35 U.S.C. 112, first paragraph issues for more than a decade, and now gives now clear substantive basis for the paroxysmal change. Furthermore, a 35 U.S.C. 101 issue involves utility. I discussed this in detail on pages 111 through 119 in the Appeal Brief.

9. The Office's Communication inaccurately states, "Notwithstanding this, the statements regarding the 35 U.S.C. 102 and 103 rejections are still improper because the specific prior art used as basis for the unpatentability determination have not been identified." The Office is wrong. I identified specific prior art on pages 72 through 100 in the Appeal Brief, and as cited in said Notice stated on page 4.

10. The Office's Communication inaccurately states, ".... there is not discussion in the Arguments section of why EACH claim is considered separately patentable." The Office is wrong. It was corrected on page 10 in the Appeal Brief in the ISSUES section, and then on page 11 of the Argument section for 35 U.S.C. 112 (first paragraph), and then on page 62 of the Argument section for 35 U.S.C. 112 (second paragraph), and then on page 72 of the

Argument section for 35 U.S.C. 102, and then on page 90 of the Argument section for 35 U.S.C. 103, and then on page 111 of the Argument section for 35 U.S.C. 101.

11. The Office's Communication inaccurately states, "4. The Arguments section is still incomplete and improper. The Office is wrong . It was discussed on pages 11 through 61 of the Argument section for 35 U.S.C. 112 (first paragraph), and then on pages 62 through 71 of the Argument section for 35 U.S.C. 112 (second paragraph), and then on pages 72 through 89 of the Argument section for 35 U.S.C. 102, and then on pages 90 through 110 of the Argument section for 35 U.S.C. 103, and then on pages 111 through 119 of the Argument section for 35 U.S.C. 101.

12. The Office's Communication inaccurately states, "... there is not discussion in the Arguments section of why EACH claim is considered separately patentable." The Office is wrong. I addressed this matter in my "Notice of Compliance by Appellant", dated Sept. 17, 2003 on 5. Furthermore, I did correct it on page 10 in the Appeal Brief in the ISSUES section, and then on page 11 of the Argument section for 35 U.S.C. 112 (first paragraph), and then on page 62 of the Argument section for 35 U.S.C. 112 (second paragraph), and then on page 72 of the Argument section for 35 U.S.C. 102, and then on page 90 of the Argument section for 35 U.S.C. 103, and then on page 111 of the Argument section for 35 U.S.C. 101, as said Notice stated on page 5.

13. The Office's Communication inaccurately states, "Not all grounds for rejection have been addressed, e.g., new matter rejection under section 9 of the Final Office Action.". The Office is wrong. I discussed this on pages 3 and 4 in said Notice, and discussed it on pages 68 through 78 in the Appeal Brief, as said Notice stated on pages 3 and 4.


14. The Office's Communication inaccurately states, "Since the above deficiencies have been listed in the 8/29/03 Office Action, Applicant's failure to correct them is no longer considered inadvertent." The Office is wrong because there are no "deficiencies". The Office is wrong because I did NOT fail to correct them. This was discussed on pages 2 though 5 of said Notice.



Mitchell R. Swartz, ScD, MD

I declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

Signature of Inventor:
November 23, 2003



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